



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,035	05/03/1999	GIORGIO J. VANZINI	MSI-254US	9156

22801 7590 08/19/2003

LEE & HAYES PLLC  
421 W RIVERSIDE AVENUE SUITE 500  
SPOKANE, WA 99201

EXAMINER
----------

KIM, AHSHIK

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/304,035

Applicant(s)

VANZINI ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07/28/03 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Receipt of Response*

1. Receipt is acknowledged of the response filed on July 28, 2003. Claims 1-6 and 22-26  
5 remain for examination. In listing presented claims, the Applicant stated "Claims 27-28:  
Canceled" which should have been "Claims 27-38: Canceled". Appropriate correction is  
required in subsequent response.

### *Claim Rejections - 35 USC § 102*

10 2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on  
15 sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Harari  
et al. (US 5,887,145).

Re claims 1 and 22, Harari teaches a PCMCIA form factor device 10 (col. 3, lines 19-23;  
col. 6, lines 63+) comprising an interface 14 to communicate with a storage card 20. The card  
20 assembly 100 can be connected to a host machine/system (see abstract; col. 1, lines 13+).

Re claims 2, 3, and 23, the storage card contains various chips such as flash EEPROM  
memory (col. 7, lines 24+).

Art Unit: 2876

Re claims 4, 5, and 24, the storage card 20 further contains identifying data readable from the mother card or the host, which in turn can be used in guiding the host to use a particular device protocols or software (col. 5, lines 38+).

Re claims 6, 25, and 26, the daughter card 30 stores an assignable identity code and a  
5 secret key (private key in RSA public-key data encoding scheme) (col. 13, lines 64+). Only when the private-public keys are matched, the information can be decrypted and read.

### ***Response to Arguments***

4. Applicant's arguments filed on July 28, 2003 have been fully considered, but they are not  
10 persuasive.

Applicant argues that the Harari patent does not teach or suggest claimed invention since in the Harari patent, it is a daughter card 20, not a mother card 10 which contains flash memory (see Page 5, lines 22 thereafter in Remarks section).

In view of Applicant's argument, and careful review of claim 1, it is the Examiner's view  
15 that the Harari patent discloses the subject matter disclosed in instant application. The claim 1 recites an "assembly", and dependent claim 3 does not clearly indicate which part of the assembly where the flash memory resides. In view of the above, the Harari patent meets the assembly recited in claim 1 and the subject matter further defined in dependent claims.

The amended claims and remarks describing these elements have been given careful  
20 consideration, but they are not persuasive. Accordingly, the Examiner has made this Office Action final.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5           A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
10 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The  
15 examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-  
20 7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*  
25

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.  
30

Art Unit: 2876




Ahshik Kim

5 Patent Examiner

Art Unit 2876

August 11, 2003



MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800